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REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments, and the following remarks.

The claims are 1-4, 7 and 9. Claims 5, 6, 8 and 10-22 have been cancelled without prejudice. Claims 1-4 and 7 are as previously presented. Claim 9 has been amended as requested by the Examiner to depend from claim 1 rather than cancelled claim 8. Accordingly, it is respectfully requested that the objection to claim 9 on this basis be withdrawn.

Claims 1-4, 7 and 9 have been rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 5,552,573 to *Okita et al.* Essentially, it is the Examiner's position that *Okita et al.* discloses a resistance welding process and apparatus substantially as recited in Applicants' pending claims with the exception of the metal strips being connected by rabbeting or stamping. In the Examiner's view, although *Okita et al.* does not disclose that the connections of the metal strips are by rabbeting or stamping, one of ordinary skill in the art would have recognized that these types of connections are similar in establishing a similar result as the clad welding process

disclosed in *Okita et al.*, as all three of these types of connections result in establishing a "bond " or "joining interface" between the two metal strips, thus suggesting the feature of the two metal strips being exclusively positively connected as recited in Applicants' claim 1. Moreover, in the Examiner's view, one of ordinary skill in the art would have found it "obvious to try" these various types of connections, since the Applicants were said to be choosing from a finite number of predictable solutions with a reasonable expectation of success in order to establish the predictable result of obtaining a joining interface between the metal strips.

The rejections are respectfully traversed.

As set forth in claim 1, Applicants' invention provides a device for protection of an electrode during resistance welding of workpieces. The device includes a strip placed over the electrode, means for holding the strip over the electrode, and means for driving the strip. The strip is comprised of at least two superimposed metal strips made of different materials and the metal strips are exclusively positively connected by rabbeting or stamping, such that the strips are displaceable relative to each other.

*Okita et al.* describes a welding process and an apparatus for welding that is substantially different than Applicants' claimed device. Moreover the process and apparatus described in *Okita et al.* fail to achieve the advantages of Applicants' device where the strip held over the electrode is comprised of at least two superimposed metal strips made of different materials and exclusively positively connected by rabbeting or stamping, such that the strips are displaceable relative to each other.

In particular, *Okita et al.* discloses an insert material (9, 10) with a sheet-like core material (9a) made of iron, steel, copper, or a copper alloy and coated layers (9b, 9c) made of different materials. Contrary to the Examiner's position, *Okita et al.* does not disclose "superimposed strips" as recited in Applicants' claim 1. *Okita et al.* nowhere refers to "superimposed strips" and furthermore nowhere refers to "strips".

The insert material according to *Okita et al.* is not a superimposed strip as recited in Applicants' claim 1, but rather is a coated material formed on both surfaces of a core material by means of electroplating, hot dipping, chemical vapor deposition, cladding or the like. (See for example, *Okita et al.* at column 3, lines 55-58; column 4, lines 46-49; and column 7, lines 18-20).

The thickness of each of the coated layers according to Okita et al. is necessarily within the range of 1-100  $\mu\text{m}$  (See for example, Okita et al. at column 4; lines 16-17; column 5, lines 7-8; and column 7, lines 7-11). The overall thickness of the insert material according to Okita et al. is necessarily within the range of 0.02 - 1 mm (See for example, Okita et al. at column 4, lines 30-31; column 5, lines 21-23; and column 7, lines 6-7).

As set forth above, the insert material according to Okita et al. consists of a single core material with coated layers and Okita et al. fails to teach or suggest "two superimposed metal strips (2, 3) made of different materials, said metal strips (2, 3) being exclusively positively connected" as recited in Applicants' claim 1.

Applicants' claim 1 further provides that the claimed metal strips are:

***exclusively positively connected by rabbeting or stamping, such that the strips (2, 3) are displaceable relative to each other.***

The Examiner has taken the position that the inset materials (9) consisting of core material (9a) and coated layers (9b, 9c) according to Okita et al. are able to be displaceably held via holding means at different speeds relative to each other via

reels (22, 23, 24, 25).

FIG. 5 of *Okita et al.* shows the movement of the insert material (9, 10) as a whole with respect to the electrodes (1, 2) and the workpiece (11, 12). Contrary to the Examiner's interpretation, the coated layers (9b, 9c) and core material (9a) making up the insert material according to *Okita et al.* (which in the Examiner's view is equivalent to the strip recited in Applicants' claim 1) are certainly not displaceable relative to each other as required in Applicants' claim.

Applicant's claim 1 provides a strip **"comprised of at least two superimposed metal strips (2, 3) made of different materials, said metal strips (2, 3) being exclusively positively connected by rabbeting or stamping, such that the strips (2, 3) are displaceable relative to each other"**. The coated layers (9b, 9c) of the insert material (9) of *Okita et al.* reference are certainly not displaceable relative to the core material (9a). Thus, even if the coated layers and core material of *Okita et al.* could be considered to teach a strip comprised of two superimposed metal strips, the coated layer and core material of the *Okita et al.* reference are not displaceable relative to each other as recited in Applicants' claim 1.

As acknowledged by the Examiner, *Okita et al.* fails to disclose the connections of the metal strips by rabbeting or stamping. Contrary to the Examiner's assertions, however, one of ordinary skill in the art would not have recognized that the claimed connection is similar in establishing a similar result as the clad welding process disclosed in *Okita et al.* In particular, as set forth above, none of the connecting techniques disclosed in *Okita et al.* achieve the feature or result of the strips being "**displaceable relative to each other**" as recited in Applicants' claim 1. Moreover, *Okita et al.* nowhere teaches or suggests such a result or the desirability of such a result.

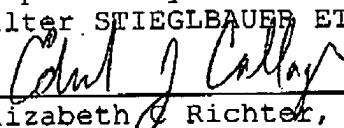
Applicants respectfully submit that it would not have been obvious to try various types of connections to establish the predictable result of obtaining a joining interface between the metal strips as asserted by the Examiner. As discussed above, Applicants' claim recites the feature of the "**strips (2, 3) being exclusively positively connected by rabbeting or stamping, such that the strips (2, 3) are displaceable relative to each other**". Thus, the result achieved by Applicants' connection is not merely a joining interface between the metal strips, but a connection wherein the strips are displaceable relative to one another. Such a result is neither obvious nor predictable in light of the teachings of *Okita et al.*

The method and apparatus described in Okita et al. also fail to achieve the advantages achieved by Applicants' device as set forth in claim 1. An advantage of an electrode protection device as provided according to Applicants' claim 1 is that such a device allow a welder to select a suitable material combination for obtaining optimum protection of the welding electrode and a high quality welded joint. The simple solution allows for a plurality of combinations of different strips to be realized by the user himself at extremely low storage costs while obtaining optimum welding quality.

For the reasons set forth above, Applicants submit that claims 1-4, 7 and 9 are patentable over the cited reference. Early allowance of the claims is respectfully requested.

Respectfully submitted,  
Walter STIEGLBAUER ET AL.

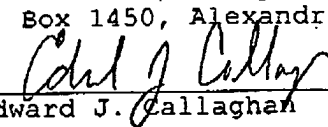
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- 10 -